

REMARKS

The instant response accompanies a Request for Continued Examination (RCE). In summary, claims 1-5, 7-12, 14-19, and 21 are pending. Claims 1-5, 7-12, 14-19, and 21 are rejected under 35 U.S.C. § 103. Independent claims 1, 8, and 15 are hereby amended to better place the application in condition for appeal or allowance. No new matter is added. Support for the claim amendments can be found throughout Applicant's application, for example at paragraphs [0035] and [0038].

Telephone Conversation With Examiner

Applicant's representative thanks Examiner Wang for the telephone conversation conducted on January 9, 2008. During the conversation, Applicant's representative explained that the cited references were not directed to building a project system. Applicant's representative and Examiner Wang discussed various possible claim amendments directed to attributes of a project system, which Applicant's representative submitted were not taught in the cited references.

Claim Rejections - 35 U.S.C. §103

Claims 1-5, 7-12, 14-19, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,412,020 issued to Leach *et al.* (herein after referred to as "Leach") in view of U.S. Patent No. 6,256,780, issued to Williams *et al.* (hereinafter referred to as "Williams").

Leach and Williams, whether considered individually or in combination, neither disclose nor suggest "configuration properties comprising at least one of an indication of a build of the project system, an output file to be created, or an indication as to where the output file will be placed" as recited in amended independent claims 1, 8, and 15, or "flavor-specific project configuration properties comprising at least one of a caption of a project node, an icon of a project node, a property allowing a project browse object to be completely overridden, a control allowing a project to be renamed, a sort priority control, a property allowing a command to be added, a property allowing a command to be removed, a property

allowing a command to be disabled, a filter, a property allowing a default generator given a file extension to be determined, or a property allowing a human-readable generator name to be mapped to a COM object” as recited in amended independent claim 1.

Leach is directed to aggregating objects (Abstract). Leach does not teach a project system, let alone specific properties of a project system. Williams is directed to assembling software components (Abstract). More specifically, Williams teaches “assembling component objects into an assembly object. The assembly object includes a connector object through which the components objects from the assembly object and through which external objects can be imported into the assembly object.” (Column 2, lines 24-29). Williams, too, does not teach a project system.

In the instant Office Action, portions of Leach and Williams are cited to support the claim rejection, but none of these portions addresses a project system as claimed.

Additionally, a *prima facie* case of obviousness has not been established because the reasoning for the rejection of all claim limitations has not been clearly articulated. Specifically, independent claims 1, 8, and 15 each recite “the base project object implements a base project configuration object that includes configuration properties for the base project object”. In the instant Office Action on pages 6, 14, and 22, it is stated that Williams discloses this limitation, but no portion of Williams is cited.

Further, no rationale as to how Williams is being interpreted is provided. Without providing rationale as to how a reference is being asserted against a claim, the burden to clearly articulate the rejection has not been met. “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and other wise reply completely at the earliest opportunity.” (Emphasis added) MPEP § 706. “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference ... shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of reference, if not apparent, must be clearly explained and each rejected claim specified.”

(emphasis added) 37 § CFR 1.104 (c)(2), MPEP 706. To anticipate a claim, a reference must teach every claimed element. MPEP § 2131. Furthermore, the examiner bears the burden of proof to show patent invalidity. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985). Such proof must amount to a preponderance of the evidence to warrant rejection of claims. *Id.* Because the rejection of the claims has not been clearly explained in view of Williams, this burden has not been met.

Additionally, the proposed modification of Leach and Williams necessary to arrive at the claimed subject matter has not been provided. Per MPEP § 706.02(j), 35 § U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 § U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Because Leach and Williams, whether considered individually or in combination, neither disclose nor suggest “configuration properties comprising at least one of an indication of a build of the project system, an output file to be created, or an indication as to where the

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37 CFR § 1.116

output filed will be placed” or “flavor-specific project configuration properties comprising at least one of a caption of a project node, an icon of a project node, a property allowing a project browse object to be completely overridden, a control allowing a project to be renamed, a sort priority control, a property allowing a command to be added, a property allowing a command to be removed, a property allowing a command to be disabled, a filter, a property allowing a default generator given a file extension to be determined, or a property allowing a human-readable generator name to be mapped to a COM object”, because the reasoning for the rejection of all claim limitations has not been clearly articulated, and because the proposed modification of Leach and Williams necessary to arrive at the claimed subject matter has not been provided, it is requested that the rejection of claims 1-5, 7-12, 14-19, and 21 under 35 U.S.C. § 103 be reconsidered and withdrawn.

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CONCLUSION

In view of the foregoing arguments, remarks, and amendments, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow this application for any reason, the Examiner is encouraged to contact the undersigned attorney to discuss resolution of any remaining issues.

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